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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,097	06/15/2001	Valerie De La Poterie	05725.0905-00	7312
22852	7590	01/11/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n N .

09/881,097

Applicant(s)

DE LA POTERIE ET AL.

Examin r

Marina Lamm

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-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13 and 15-59 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15-18, 20-56 and 59 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 10/8/04. Claims pending are 1-10, 12, 13 and 15-59. Claims 1, 55 and 56 have been amended. Claims 57 and 58 have been withdrawn from future consideration as directed to non-elected invention.

The Applicant has previously elected polycaprolactones as thermal transition agents and polyurethanes as film-forming polymers.

#### ***Claim Rejections - 35 USC § 112, second paragraph***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of Claims 12 and 13 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained for the reasons of the record. In particular, Claims 12 and 13 recite the limitation "the melting point". There is insufficient antecedent basis for this limitation in the claim. It is not clear whether the limitation refers to the melting point of the composition or to the melting point of any composition components.

#### ***Allowable Subject Matter***

3. Claim 19 is objected to as being dependent upon a rejected base claim (see below), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following rejections are applicable to the non-elected species:

***Claim Rejections - 35 USC § 112, first paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10, 12, 13, 15-18, 20-56 and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims recite the limitation "at least one thermal transition agent chosen from semi-crystalline compounds, which undergoes a change of state at a transition temperature,  $T_t$ , chosen within a temperature range from 25<sup>0</sup> C to 80<sup>0</sup> C, the at least one thermal transition agent being not water-soluble in water maintained at a temperature below the transition temperature,  $T_t$ ". The instant specification on p. 7 discloses that thermal transition agents may be semi-crystalline polymers such as polycaprolactones. There are semi-crystalline polymers that would be encompassed by the claim, that are not described in the specification. The instant claims recite a genus of semi-crystalline compounds that are defined only by their transition temperature and lack of water solubility at a temperature below the transition temperature. To provide evidence of possession of a claimed genus, the specification must provide sufficient

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distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed compound, or any combination thereof. Here, the only factor present is physical properties of the compound. There is no identification of any structures or structural elements (e.g. monomers) that this compounds must possess. Thus, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus because one skilled in the art can not structurally visualize any semi-crystalline thermal transition agents, except for the single disclosed polycaprolactones; thereby, not reasonably meeting the written description requirements of 35 U.S.C. 112, first paragraph. See MPEP 2163.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-10, 12, 13, 15-18, 20-25, 46, 47 and 52-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al. (EP 367 015), supplied by the Applicant.

Hayashi et al. teach cosmetic make-up compositions containing oils and 10% by weight of a shape memory polyurethane polymer having crystallinity value between 3 and 50%. See Abstract; col. 15, lines 5-13. The polyurethane polymer exemplified by the reference has glass transition temperature of 40<sup>0</sup>C. See col. 15, lines 5-13; Table 1,

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compound No. 39. The make-up material of Hayashi et al. "could be washed away easily using warm water at around 42-43<sup>0</sup>C". See col. 15, lines 33-34. It appears that the polyurethanes of Hayashi et al. possess the claimed hydroxyl number and molecular weight. See col. 3, lines 48-58; col. 4; Table 1. With respect to the claimed hot and cold water resistance, these limitations are inherent in the reference because the reference teaches the same polymer as disclosed herein and also teaches water-solubility of the composition in warm water having temperature above glass transition temperature of the polymers.

Thus, Hayashi et al. teach each and every limitation of Claims 1-10, 12, 13, 15-18, 20-25, 46, 47 and 52-56.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 1-10, 12, 13, 15-18, 20-56 and 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30, 32-37, 45 and 46 of copending Application No. 10/138,325 ('325). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that claimed in '325. Thus, the instant claims are directed to compositions for a keratinous material, such as mascara and other make-up and cosmetic compositions, comprising (a) at least one film-forming agent; and (b) at least one thermal transition agent chosen from semi-crystalline compounds, which undergoes a change of state at a transition temperature,  $T_t$ , chosen within a temperature range from 25° C to 80° C, the at least one thermal transition agent being not water-soluble in water maintained at a temperature below the transition temperature,  $T_t$ , wherein the at least one film-forming polymer and the at least one thermal transition agent are present in an amount which is sufficient so that the composition is capable, at the temperature of the keratinous material, of forming a film having a resistance ( $R_c$ ) to hot water maintained at 40° C, of less than or equal to

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15 minutes, and a resistance (Rf) to cold water, maintained at 20<sup>0</sup> C such that  $R_f - R_c \geq 8$  minutes, and further wherein said at least one film-forming polymer and said at least one thermal transition agent are the same or different. The claims of '325 are directed to a composition comprising, in a physiologically acceptable medium, at least one first semi-crystalline polymer having a melting point of greater than or equal to 30<sup>0</sup> C, and at least one second film-forming polymer that is capable of forming a hydrophobic film at room temperature, wherein the composition is being removable with warm water. Therefore, the claims of '325 overlap with the subject matter of the instant claims with respect to the non-elected species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

10. Applicant's arguments, see response filed 10/8/04, with respect to the rejection(s) of claim(s) 1-10, 15-31, 46-56 and 59 over Hoefer et al. (US 5,312,865) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

11. Applicant's arguments, see response filed 10/8/04, with respect to the rejection(s) of claim(s) 1-10, 12, 13, 15-18, 20-56 and 59 under 35 U.S.C. 112, first paragraph for the scope of enablement have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. See above.



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12. Applicant's arguments with respect to the indefiniteness rejection of Claims 12 and 13 have been fully considered but they are not persuasive. In response to the Applicant's argument that the recited melting point is an inherent element of the claimed composition, it is noted that the claim language is confusing as to what melting point is recited since either of the recited components as well as the composition itself can have a melting point.

***Conclusion***

13. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

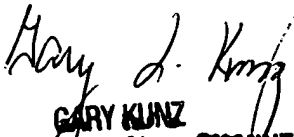
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GARY KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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